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PATENT
Attorney Docket No. 1222.0034

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)
David A. Russo et al.)
Serial No.: 08/544,212) Group Art Unit: 1108
(Original Patent 5,401,305 issued)
March 28, 1995, Original Serial) Examiner: D. Brunsman
No. 104,125 filed December 13, 1993)
Filed: October 17, 1995)
For: COATING COMPOSITION FOR GLASS)
Owner of Record: Elf Atochem North)
America, Inc.)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

SUBSTITUTE DECLARATION OF STANLEY A. MARCUS

I, Stanley A. Marcus, declare and state as follows:

1. I am Patent Counsel for the assignee of the above-identified patent and reissue application, Elf Atochem North America, Inc., and was one of the attorneys appointed by David A. Russo, Ryan R. Dirkx, and Glen P. Florczak to prosecute the application leading to United States Patent No. 5,401,305 ("the '305 patent"). I submit this substitute declaration in response to the March 3, 1997 communication from the Examiner.

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000

2. Subsequent to its issuing, I became aware that the claims of the '305 patent, through an error, claimed less than Messrs. Russo, Dirkx, and Florczak had a right to claim as inventors. In my opinion, as a result of this error, the '305 patent is partially inoperative.

3. I discovered in particular, the claims of the '305 patent relate to a gaseous composition adapted to deposit at least a first layer of tin oxide and silicon oxide onto glass at a rate of deposition greater than about 350 Å/seconds, wherein the composition comprises a precursor of tin oxide, a precursor of silicon oxide or formula $R_mO_nSi_p$, an accelerant selected from the group consisting of organic phosphites, organic borates, and water and mixtures thereof, and a source of oxygen. The claims as presented in the amendment attached to the original Russo et al. Reissue Declaration and the October 18, 1995 and November 27, 1996 amendments are different in that they relate to a gaseous mixture comprising at least one metal oxide precursor, an accelerant, and a precursor for silicon oxide, a film comprising at least one metal oxide and an accelerant, and also relate to a layer comprising at least one metal oxide and an accelerant deposited on a substrate.

4. The present reissue application claims priority of Application Serial No. 07/814,366, filed December 26, 1991 (the "great grandparent application"), Application Serial No. 07/814,352, filed December 27, 1991 (the "grandparent application"), PCT Application PCT/US92/10873 filed 21, December 1992 (the "PCT application") designating the United States for filing the application as a continuation-in-part and Serial No. 08/104,125 filed December 13, 1993 (the "parent application").

5. The great grandparent application in this regard claimed in claim 1, a composition for coating a substrate that comprised at least one metal-oxide precursor and one deposition-rate-enhancing material. Claims 2-4 claimed a transparent substrate such as glass, whereas claim 5 included a silicon oxide precursor in the composition, and claims 6 and 7 described the metal-oxide precursor as a tin oxide precursor. Claims 8-19 described the various deposition-rate-enhancing substances, and claims 20-50 described the various articles of manufacture produced with the claimed composition including the composition applied as at least one layer or a plurality of layers.

6. The grandparent application in claim 1, claimed a method for depositing a film onto a substrate with at least deposition-rate-enhancing substance. Claims 2-5 described the substrate as brittle, transparent and specifically a glass whereas claim 6 described the layer as comprising metal and silicon oxides. Claims 7-10 described the method in terms of metals comprising tin and non-metals such as silicon, boron, and phosphorous or the oxides thereof, whereas claims 11-13 described the method in terms of depositing one or more layers of the composition. Claims 14-21 defined the deposition-rate-enhancing substances, whereas claims 22-27 described the method as applied to forming a plurality of layers having a separate refractive index and the various materials employed in forming the layers. Claims 28-51 claimed various articles of manufacture employing the method.

7. The written description of the great grandparent and grandparent application also described all of the foregoing claimed subject matter.

8. At the time of filing the PCT application which forms the basis for the parent application, the PCT claims employed a format for submission to 23 of the designated PCT states in addition to the United States. Although the PCT application contained claims to a "composition" they included both process, product, and article of manufacture limitations. Claim 1 of the PCT application claimed a composition, but claim 2 contained temperature limitations for the application of the composition on to a flat glass substrate, whereas claim 4 described the glass substrate as moving and the application of the composition in a continuous manner. Claim 5 contained further temperature limitations for the application of the coating and claim 16 described a rate of deposition. Claims 25 and 26 also contained process limitations for the deposition of the composition, as at least a first layer, at specific temperature and pressure conditions as well as deposition rates. Claim 26 contained additional temperature limitations and also described applying the composition to a substrate by means of a continuous process.

9. The PCT claims also described the composition in terms of process and article of manufacture limitations. Claim 3, described the application of the composition to produce a glass article having no reflected color in daylight. Claims 17-23 contained product limitations in that they further describe the composition *inter alia* as adapted to provide an amorphous first layer (claim 17), a plurality of layers (claims 18, 19, 22, and 23), and further gave the composition of one of the layers (claims 19 and 20), and the refractive index of one of the layers (claim 21).

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000

10. I do not in any way intend to limit the claims of any of the foregoing applications by the summaries of claims of those applications as set forth herein.

11. An amendment in the parent application structured the PCT claims to conform to United States composition of matter claim practice. As a result of error, without deceptive intention, these claims were not amended to specifically include process, product and article of manufacture claims when the PCT application entered the national phase in the United States as the parent application. The more inclusive invention as set out in the written description of the parent application as well as the specifications, (i.e., the written description and claims) of the great grandparent and grandparent applications was erroneously excluded without deceptive intent from coverage in the claims of the parent application but which the reissue application claims now cover.

12. The misunderstanding or error arising from the scope of Russo et al.'s invention occurred without any deceptive intention on the part of the applicants, assignee, or applicants' counsel.

13. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000

Date: March 20, 1998



Stanley A. Marcus

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
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